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| 09/936,303 | 12/26/2001 | Christophe Genevois | 07904.0050 | 3636 |

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| EXAMINER |
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VAN HANDEL, MICHAEL P

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| ART UNIT | PAPER NUMBER |
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2617

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------------------|--|--|
| Office Action Summary | Application No. 09/936,303 | Applicant(s) GENEVOIS ET AL. | |
| | Examiner Michael Van Handel | Art Unit 2617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims **1-4, 6-14** are rejected under 35 U.S.C. 102(e) as being anticipated by Maillard et al.

Referring to claims **1** and **4**, Maillard et al. discloses a system, comprising:

- an electronic purse card (p. 12, paragraphs 254, 255 & p. 14, paragraph 283)(Figs. 18-19); and
- a module associated with a subscriber, said module comprising a protected local storage and a remote communication channel, wherein:
 - o said module is adapted to debit an amount to said electronic purse card, said amount corresponding to an entitlement of said subscriber to receive and/or unscramble a particular content (p. 14, paragraphs 279, 283);
 - o said module is adapted to store transaction data in said protected local storage, said transaction data comprising said entitlement and said amount (p. 10, paragraph 224 & p. 14, paragraph 288);

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- said module is adapted to protect said transaction data against unauthorized access (the examiner notes that the data must be deciphered before being added to a callback information storage file 3214 for later processing and passing to the SMS 3004)(p. 10, paragraph 224); and
- said module is adapted to enable said entitlement locally (p. 14, paragraph 282), and send on demand said transaction data to a content provider via said remote communication channel (the examiner notes that the receiver/decoder sends the cipher information at a time/date specified in a previously received EMM)(p. 10, paragraphs 223-224)(Fig. 20).

Referring to claim 2, Maillard et al. discloses a system according to claim 1, wherein said electronic purse card comprises prepaid value points on a value register 163 in said protected local storage (p. 14, paragraph 279), said amount corresponding to multiple value points (tokens), wherein said module is adapted to deduct said multiple value points from said prepaid value points, store said debit on said value register (p. 14, paragraph 283), and send said multiple points (the number of remaining tokens) to said content provider (p. 10, paragraph 224).

Referring to claim 3, Maillard et al. discloses a system according to claim 2, wherein said electronic purse card is adapted to remain in said module as long as prepaid value points are available on said value register (the examiner notes that the smartcard 3020 of Maillard et al. is removably inserted into a card reader of conventional design)(p. 2, paragraph 34 & p. 12, paragraph 254).

Referring to claim 6, Maillard et al. discloses a system according to claim 4, wherein said conditional access module comprises a smartcard reader (p. 12, paragraph 254).

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Referring to claim 7, Maillard et al. discloses a system according to claim 1, further comprising an interface device comprising said module, wherein said interface device connects a user terminal and broadcast channel (p. 3-4, paragraph 86).

Referring to claims 8-10, Maillard et al. discloses a system according to claim 1, wherein said module/subscriber card/electronic purchase card comprises a software module adapted to merchant security (random numbers are generated in order to diversify transaction output signals)(p. 12, paragraph 258).

Referring to claim 11, Maillard et al. discloses a system according to claim 1, wherein said protected local storage comprises separate address spaces, said separate address spaces adapted to access by different contact providers (p. 13, paragraph 261)(Fig. 19).

Referring to claim 12, Maillard et al. discloses a system according to claim 1, further comprising a license certificate, comprising at least one data chosen from:

- a datagram derived from an entitlement management message, said message received from said content provider (p. 10, paragraph 221);
- a certificate of payment derived from said transaction data (p. 14, paragraph 283);
- a subscriber number (position of subscriber in group)(p. 5, paragraph 114); and
- a unique code, said unique code derived as a function of said datagram and said subscriber number (unique EMM)(p. 5, paragraph 114).

The USPTO considers the applicant's "at least one data chosen from" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Referring to claim 13, Maillard et al. discloses a system according to claim 12, further comprising a file comprising said content (p. 5-6, paragraph 120).

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Referring to claim 14, Maillard et al. discloses a system according to claim 13, wherein said file further comprises said license certificate (p. 5-6, paragraph 120).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maillard et al. in view of Metz et al.

Referring to claim 5, Maillard et al. discloses a system according to claim 4. Maillard et al. does not disclose using a PCMCIA form factor card. Metz et al. discloses a digital entertainment terminal (DET) that includes a personal computer memory-card interface adaptor (PCMCIA) port 155. It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Maillard et al. to include a PCMCIA port, such as that taught by Metz et al. in order to provide a user with a means for connecting a smartcard via a standard interface.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Giachetti et al. discloses a process for the broadcasting of programs with progressive conditional access and separation of the information flow and the corresponding receiver.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Van Handel whose telephone number is 571.272.5968. The examiner can normally be reached on Monday-Friday, 8:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 571.272.7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Van Handel
Examiner
Art Unit 2617

MVH



VIVEK SRIVASTAVA
PRIMARY EXAMINER